

REMARKS

Applicant has carefully studied the Office Action of May 7, 2004 and offers the following remarks to accompany the above amendments.

Initially, Applicant appreciates the indication that claims 3-5, 8 and 10 contain allowable subject matter. Applicant herein amends claims 3, 5, 8, and 10 to independent form. These claims are now in condition for allowance rather than being dependent upon a rejected base claim. Claim 4 depends from claim 3, and likewise should be in condition for allowance.

Claims 1, 2, 6, 7, 9, and 11-25 were rejected under 35 U.S.C. § 103 as being unpatentable over Guercio et al. (hereinafter "Guercio") in view of Creamer et al. (hereinafter "Creamer"). Applicant respectfully traverses. For the Patent Office to combine references, the Patent Office must do two things. First, the Patent Office must provide a motivation to combine references, and second, the Patent Office must support the motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once the combination is made, for the Patent Office to establish *prima facie* obviousness, the Patent Office must still show where each and every claim element is located. MPEP § 2143.03.

In the Office Action of May 7, 2004, the Patent Office opines that the motivation to combine the references is to provide service "to from a PSTN to IP connection." It is not entirely clear that the recitation is a motivation to combine the references. Moreover, the recitation is not supported by the actual evidence that the Federal Circuit has mandated be present for all combinations. Since the actual evidence is missing, the combination is improper and the references must be considered individually. The Patent Office admits that Guercio does not teach all the elements of the independent claims, and thus Guercio cannot render the claims obvious. Likewise, Creamer does not show the selective ring tones recited in the claims, and cannot render the claims obvious.

Even if the combination is proper, the combination does not show all the claim elements. Specifically, claim 1 recites, "sending the indicia associating the telephone number of the expected caller with the audio file from the application server to the telephony device. . . ." In contrast, the combination of Guercio and Creamer does not teach or suggest this step. Specifically, the combination of Guercio and Creamer results in a server that receives caller ID information (pursuant to the teachings of Creamer), and then presumably forwards this caller ID information to the called party. Then, the phone of Guercio evaluates the caller ID information

and selects the appropriate recorded announcement to play between the normal ring signals (pursuant to Guercio col. 7, lines 44-47). However, this combination results in Guercio's phone doing the matching. Since Guercio's phone does the matching, the application server cannot send the indicia associating the telephone number with the audio file to the telephony device as recited in the claim. To this extent, the combination does not teach or suggest a claim element and the rejection does not establish *prima facie* obviousness. Since the rejection does not establish *prima facie* obviousness, claim 1 and its dependent claims, 2, 6, 7, 9, and 11, are patentable.

Independent claims 12, 19, 20, and 23-25 are patentable at least for the reason that the combination is improper. Likewise, dependent claims 13-18, 21, and 22 are patentable for at least the same reasons.

Claim 14 deserves special mention in that claim 14 recites that "determining, at the application server, if the telephone number is associated with the audio file within the plurality of available audio files. . . ." As noted above, the combination of Guercio and Creamer leaves the determining step in the telephony device, not in the application server. To this extent, the combination of references does not teach or suggest this claim element, and the combination does not establish obviousness.

Claim 19 deserves special mention in that it recites, "send the indicia associating the telephone number of the expected caller with the audio file to the telephony device via the network interface. . . ." The combination of Guercio and Creamer stores the audio file in the telephony device from its creation. Therefore, the combination does not send the indicia to the telephony device. As such, the combination does not show a claim element and the claim is non-obvious.

Claim 20 deserves special mention in that it recites that the application server's control system is adapted to do elements i-iii. That is, the control system selects the audio file and effects playback. As previously explained, the selection and effecting playback of the combination take place in the telephony device, not in the application server, and thus the combination does not teach or suggest the claim element. As such the claim is non-obvious.

Claims 21 and 22 depend from claim 20 and are patentable for this additional reason. Likewise, claim 21 recites the application server's control system receiving the audio file. As noted, the combination stores the audio file in the telephony device, not in the application server,

so the application server of the combination cannot receive the audio file as recited in the claim. Since the combination does not teach this element, the claim is non-obvious.

Claim 23 is similar to claim 19 and is patentable at least for the same reasons.

Applicant requests reconsideration of the rejection in light of the remarks and amendments presented herein. The combination is improper and even if the combination is proper, the combination does not teach the application server performing certain functions as recited in the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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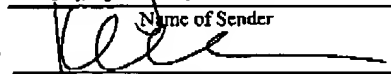
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